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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,191	02/15/2007	Sam Adler	P-5608-US	6216
49443 7590 08/10/2010 Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036				
EXAMINER SMITH, RUTH S				
ART UNIT		PAPER NUMBER		
3737				
MAIL DATE		DELIVERY MODE		
08/10/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/541,191

**Applicant(s)**

ADLER ET AL.

**Examiner**

Ruth S. Smith

**Art Unit**

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 8 and 11 are rejected under 35 U.S.C. 102(b) as being unpatentable over Meah (US Patent No. 6,257,238). Meah discloses an apparatus and method for upper gastrointestinal endoscopy with tongue depressor, which involves inserting a sensing device into the subject's body lumen and imaging and receiving the information from the lumen. (col. 2, lines 53-54 and col. 1, lines 10-26). The method involves emptying the subject's body lumen prior to inserting the sensing device (col. 4, lines 9-14) and placing the subject on his side for upper gastrointestinal endoscopy (col. 3, line 67- col. 4, line 2).

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being unpatentable over Nakaichi et al. (US Patent. No. 6,319,195). Nakaichi et al. discloses a method of operating the endoscope that comprises inserting the sensing device into the subject and receives the data transmitted from the sensing device (col. 9, lines 58-64 and abstract). The method further comprises positioning the subject on his back (col. 11, lines 30-56).

Claim 1 is rejected under 35 U.S.C. 102(e) as being unpatentable over Takizawa et al. (US Pub. No. 2003/0020810). Takizawa et al. discloses a capsule type medical apparatus for in vivo sensing of a body lumen (fig. 5a-5d). Takizawa et al. discloses inserting a sensing device into the subject's body lumen and receiving the data transmitted by the sensing device. Takizawa et al. further discloses positioning the subject in the horizontal position and imaging the body lumen (paragraph 0044 and 0083).

Claims 1, 4 are rejected under 35 U.S.C. 102(e) as being unpatentable over Bonner et al. (US Pub. No. 2004/0082850). Bonner et al. discloses a method and apparatus for locating body vessels. The method involves inserting a sensing device into a subject's body lumen (abstract) and receives the data transmitted from the sensing device (paragraphs 0055 and 0056). Bonner et al. further discloses positioning the subject horizontally on his side (paragraph 0084).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meah (US Patent No. 6,257,238). Meah discloses an apparatus and method for upper gastrointestinal endoscopy, which involves placing the subject on his side for upper gastrointestinal endoscopy (col. 3, line 67- col. 4, line 2) and emptying the subject's body lumen prior to inserting the sensing device (col. 4. lines 9-14). An upper endoscopy procedure is used to visualize parts of the gastrointestinal tract including the stomach. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Meah's invention and use the invention by positioning the subject in different position to allow the sensing device to easily and slowly pass through the lumen for obtaining multiple images in short period of time.

Claims 5, 12-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa et al. (US Pub. No. 2003/0020810), in view of Yokoi et al. (US Patent No. 7,083,579). Takizawa et al. discloses the invention described above. However, Takizawa et al. fails to disclose swallowing the sensing device with water. Yokoi et al. discloses an encapsulated medical device for examining internal regions of the body (abstract). The medical device takes the data related to subject's upper GI tract and transmits the data to the receiving unit in real time (col. 8, line 51 – col. 9, line 41). The medical device is inserted into the body by swallowing the medical device with water (col. 6, lines 9-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Takizawa's invention to swallow the sensing device with water. The water will inherently reduce the amount of saliva in the mouth for comfortable swallowing of the device. With respect to claims 13,14, in the absence of any showing of criticality, the amount of time that a person keeps their mouth open after swallowing the device would be obvious to determine to achieve the desired results without undue experimentation.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaichi et al. (US Patent. No. 6,319,195), in view of Maruta (US Patent No. 5,980,462)

Nakaichi et al. discloses a method of operating the endoscope that comprises inserting the sensing device into the subject and receives the data transmitted from the sensing device (col. 9, lines 58-64 and abstract). The method further comprises positioning the subject on his back (col. 11, lines 30-56). Nakaichi discloses the invention described above. However, Nakaichi fails to disclose filling the subject body lumen with water. Maruta discloses an ultrasonic diagnostic device and ultrasonic endoscope. The ultrasonic endoscope is adapted to be inserted into the body cavity and receive the data (col. 4, lines 43-60). Maruta further discloses filling the subject body lumen with water (col. 9, lines 52-64). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nakaichi's invention and fill the subject body lumen with water for obtaining uniform medium for the propagation of ultrasonic waves to obtain images with better resolution.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaichi et al. (US Patent No. 6,319,195), in view of Maruta (US Patent No. 5,980,462), as applied to claim 9 above, and further in view of Phillips et al. (US Patent No. 5,122,362). Nakaichi et al. and Maruta discloses the invention described above. However, Nakaichi et al. and Maruta fails to disclose ingesting 200ml or above of water. Phillips et al. discloses a method for the measurement of glucose tolerance. The method involves drinking 300 ml of water (col. 11, lines 63-68). The method further involves obtaining images by placing a camera interiorly (col. 12, lines 60-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nakaichi's invention and use a method of drinking 300 ml of water as taught by Phillips et al. to acquire images at different conditions to illustrate physiological changes in the stomach.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meah (US Patent No. 6,257,238), as applied to claim 19 above, and further in view of Yokoi et al. (US Patent No. 7,083,579). Meah discloses the invention described above. However, Meah fails to disclose drinking and filling the stomach with

water. Yokoi et al. discloses an encapsulated medical device for examining internal regions of the body (abstract). The medical device is inserted into the body by swallowing the medical device with water (col. 6, lines 9-16). It would have been obvious to one of ordinary skills in the art at the time of the invention to drink 200 ml of water and fills the subject body stomach before inserting Meah's endoscope in the stomach for testing and comparing the endoscopic images with and with filling the stomach with water for evaluation purposes.

Claims 6, 7, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa et al. (US Pub. No. 2003/0020810), in view of Yokoi et al. (US Patent No. 7,083,579), as applied to claims 5 and 15 above, and further in view of Takaichi et al. (US Patent No. 5,437,880). Takizawa et al and Yokoi et al. discloses the invention described above. However, Takizawa et al and Yokoi et al. fails to disclose a saliva reducing agent that contains oil and glycerin. Takaichi et al. discloses a health drink composition. The drink composition contains glycerin (col. 4, lines 29-44) and oil (col. 3, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Takizawa's invention and swallow Takizawa's sensing device after drinking Takaichi's health drink composition that reduces the saliva in the mouth and contains oil and glycerin which causes the inner surfaces of the mouth smooth and less resistive for easy and comfortable swallowing of the sensing device.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meah (US Patent No. 6,257,238), as applied to claim 19 above, and further in view of Mullick et al. (US Patent No. 7,039,453). Meah discloses the invention described above. However, Meah fails to disclose an imaging device that includes a ballast. Mullick discloses a miniature ingestible capsule for imaging internal organs of the body. The capsule includes a ballast (col. 8, lines 53-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Meah's invention and include a ballast on the capsule as taught by Mullick et al. for keeping the imaging

device in one orientation while flowing through the lumen to obtain the images of the required locations.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application Serial No. 11/452,404 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ruth S. Smith/  
Primary Examiner, Art Unit 3737

RSS